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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91200832
Party	Plaintiff Briggs & Stratton Corporation
Correspondence Address	ROBERT N PHILLIPS REED SMITH LLP 101 SECOND STREET, STE 1800 SAN FRANCISCO, CA 94105 UNITED STATES ipdocket-chi@reedsmith.com, nborders@reedsmith.com, robphil- lips@reedsmith.com, ddaugherty@whdlaw.com, dkalahale@rddsmith.com
Submission	Reply in Support of Motion
Filer's Name	Robert N. Phillips
Filer's e-mail	robphillips@reedsmith.com, dkalahale@reedsmith.com, sher- ring@reedsmith.com
Signature	/s/ Robert N. Phillips
Date	11/19/2014
Attachments	Opposers' Reply In Support of Motion to Compel Production of Documents from Applicant.pdf(38128 bytes) Declaration of Robert N. Phillips In Support of Opposers' Reply Re Motion to Compel.pdf(10766 bytes) Exhibit A to Phillips Declaration.pdf(100062 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

BRIGGS & STRATTON CORPORATION and
KOHLEK CO.,

Opposers,

v.

HONDA GIKEN KOGYO KABUSHIKI KAISHA,

Applicant.

Opposition No. 91200832 (parent)

Opposition No. 91200146

Application Serial No. 78924545

**OPPOSERS BRIGGS & STRATTON CORPORATION AND KOHLER CO.'S REPLY IN SUPPORT
OF MOTION TO COMPEL PRODUCTION OF DOCUMENTS FROM APPLICANT HONDA
GIKEN KOGYO KABUSHIKI KAISHA**

INTRODUCTION

In its opposition brief, Applicant Honda Giken Kogyo Kabushiki Kaisha ("Honda" or "Applicant") fails to properly justify its refusal to produce documents responsive to two categories of Opposers' Requests for Production: 1) documents concerning Applicant's GP120 and GP 200 Engines (the "GP Engine Requests") and 2) documents concerning Applicant's knowledge of certain engines put out by third parties that are highly similar in shape, configuration and function as the Proposed Mark (the "Third Party Engine Requests").¹ Applicant has failed to demonstrate that Opposers' document requests lack relevance, and Applicant failed to submit any evidence supporting its claim that producing the documents would be unduly burdensome. Parties cannot avoid discovery obligations by stating in a conclusory fashion that production would be burdensome. Furthermore, in an attempt to avoid producing the relevant documents, Applicant devoted most of its Opposition to Opposers' Motion to Compel (the "Opp.") debating the merits of Opposers' opposition grounds, i.e.

functionality, lack of secondary meaning, genericness and abandonment. However, this misconstrues the discovery standard. A party cannot avoid discovery obligations by simply denying the factual assertions against it. Instead, documents are discoverable under a broad standard – that is, if they are “relevant to the subject matter involved in the action . . .” Fed. R. Civ. P. 26(b)(1). As demonstrated below, there can be no reasonable question that the document requests are relevant to the grounds asserted by Opposers in this proceeding. Because Applicant refused to produce documents pursuant to the GP Engine Requests and the Third Party Engine Requests, and because it has failed to show that production would be unduly burdensome, the Board should compel production of the requested documents.

ARGUMENT

I. OPPOSERS SATISFIED THEIR MEET AND CONFER OBLIGATIONS

As an initial matter, Opposers fulfilled their obligations under 37 CFR § 2.120(e)(1). Honda’s complaints about Opposers’ meet and confer efforts ring hollow, and are belied by the written record. As detailed in Opposers’ Motion, the parties engaged in several telephone conferences and email exchanges regarding the disputed requests which demonstrate Opposers’ good faith effort to resolve these discovery issues. Motion at 8 – 9. Furthermore, contrary to Honda’s allegation that “no such communication was made [regarding reaching an impasse] with respect to the GP Engine Requests,” the parties reached on impasse on *both* categories of requests before Opposers filed its Motion to Compel. Opp. at 7. Specifically, on June 3, 2014, after Opposers explained their relevancy, Honda made it clear that it would not produce any documents responsive to the GP Engine Requests. Decl. of Phillips ¶ 7, Ex. E. At that point, the parties were at an impasse as to those requests.

¹ Except as otherwise noted, defined terms used herein have the same meaning as set forth in Opposers’ Motion to

Opposers waited until the meet and confer process with Honda was complete on the Third Party Engine Requests before filing their Motion so that the Board would not be burdened with multiple filings. The delay, if there was any, was caused by Honda's shifting positions on the Third Party Engine Requests, first agreeing to search its files and comply with the requests, then attempting to unilaterally restrict the production, only to announce two months later, on August 5, 2014, that they would not comply with the requests. Decl. of Phillips ¶ 10, Ex. H. In the interest of efficiency, Opposers waited until the meet and confer process was complete to file a single motion rather than burden the Board with multiple motions. As the record makes clear, Opposers made a good faith effort to resolve these discovery issues, and diligently moved to compel once all issues were ripe.

II. THE BOARD SHOULD COMPEL THE PRODUCTION OF THE REQUESTED DOCUMENTS BECAUSE THEY ARE RELEVANT TO THE ISSUES IN THIS PROCEEDING

A. Opposers Are Entitled to All Documents That Are Relevant and Likely to Lead to Admissible Evidence

Honda attempts to avoid its discovery obligations by arguing against the merits of Opposers' claims. Honda misconstrues the discovery standard. Discovery is appropriate where the subject matter of the request "is relevant to the claim or defense of any party." Fed. R. Civ. P. 26(b). "Relevance" at the discovery stage is broadly construed and is given liberal treatment. *Id.*; *Varian Associates v. Fairfield-Noble Corp.*, 188 USPQ 581, 582 (TTAB 1975) (stating that relevancy is to be construed liberally). Therefore, Opposers' Motion is proper because the documents sought are highly relevant to this proceeding.²

Compel Production of Documents

² Honda's reliance on *Frito-Lay* is misplaced. *Frito-Lay* does not stand for the proposition that discovery in Board proceedings is always limited. Instead, the *Frito-Lay* Board stated that since Board proceedings are of limited jurisdiction, namely registration of marks, discovery in Board proceedings is more limited than in federal court actions where there are often multiple claims. See *Frito-Lay N. Am. Inc., v. Princeton Vanguard, LLC*, 100 U.S.P.Q2d 1904 (T.T.A.B. 2011).

B. Documents Relating to Third Party Engines, including Honda's Knowledge of Them, Are Relevant to Functionality, Lack of Secondary Meaning, Genericness And Abandonment

First, the Third Party Engine Requests are relevant to functionality. A determination of functionality can involve the consideration of “facts pertaining to the availability of other designs.” *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1340 – 1341, 213 USPQ 9, 15-16 (C.C.P.A. 1982). Since the preservation of competition is an important policy underlying the functionality doctrine, “[i]n determining ‘functionality,’ the Board must assess the effect registration of a mark would have on competition.” *Valu Eng’g, Inc. v. Rexnord Corp.*, 278 F.3d 1268, 1277, 61 USPQ2d 1422, 1428 (Fed. Cir. 2002). Where evidence indicates that the applicant’s configuration is the best or one of a few superior designs available, this evidence will strongly support a finding of functionality. *See, e.g., In re Dietrich*, 91 USPQ2d 1622, 1636 (TTAB 2009) (“[T]he question is not whether there are alternative designs that perform the same basic function, but whether the available designs work ‘equally well.’”) (citations omitted); *In re Gibson Corp.*, 61 USPQ2d 1948, 1951 (TTAB 2001) (finding that applicant had not shown there were alternative guitar shapes that could produce the same sound as applicant’s configuration). The Third Party Engine Requests are narrowly tailored to obtain information regarding Applicant’s knowledge of similarly shaped third party engines. These documents are directly relevant to functionality as they seek information relevant to whether the configuration of the Proposed Mark is the one of the few superior designs available because it is the most efficient, compact shape, which is necessary to fit into power equipment products. Likewise, the requests seek information that will show that this is an industry standard compact engine configuration and thus, what effect registration of the Proposed Mark might have on competition. All of this is relevant to the functionality analysis and therefore, the Board should compel production.

Second, Opposers contend that the industry does not associate the Proposed Mark exclusively with Applicant and therefore, lacks secondary meaning. Evidence of exclusive use of the mark, or lack thereof, is relevant to the secondary meaning analysis. *See Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549 (TTAB 2009). It is well settled that evidence of third party use of the same or similar product configuration is relevant to show that the configuration is not associated with a single source and therefore has not acquired distinctiveness as a trademark. *See In re Mars Inc.*, 105 U.S.P.Q.2d 1859 (T.T.A.B. 2013) (finding that package design failed to function as a trademark because of evidence of similar designs used by competitors. In an alternative holding, the shape was held to be functional); *EFS Mktg v. Russ Berrie & Co.*, 76 F.3d 487, 37 U.S.P.Q.2d 1646 (2d Cir. 1996) (“troll” doll design cannot be inherently distinctive or have acquired secondary meaning because at least twenty other companies sell similar designs). Here, the Third Party Engine Requests seek information regarding horizontal shaft engines from specifically identified third parties who offer them in a highly similar cubic shape and configuration as the Proposed Mark (e.g. with high mount air cleaners). Thus, these requests are directly relevant to Opposers’ claim that the Proposed Mark lacks exclusivity in the marketplace and has not acquired secondary meaning.

Third, Applicant’s knowledge of third party engines is also relevant to abandonment and genericness. Product configurations, like the Proposed Mark, can become generic. *Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 2009 WL 1017284, at * 5 (TTAB 2009) (“generic name” in Section 14 of the Lanham Act 15 U.S.C. Section 1064(3), “must be read expansively to encompass anything that has the potential but fails to serve as an indicator of source, such as . . . trade dress”). A finding of genericness will preclude Honda from registering its Proposed Mark. *See Stuart Spector Designs, Ltd. v. Fender*

Musical Instruments Corp., 94 USPQ2d 1549, 2009 WL 1017284, at *5 – 6 (TTAB 2009).

Here, the Third Party Engine Requests are relevant insofar as they may lead to information regarding the existence of widespread use of highly similar third party designs in the marketplace which has caused the Proposed Mark to become a generic industry standard, and necessary for compact fitting and placement within the equipment that the engines are designed to power (e.g. power washers, tillers etc.). Responsive documents may also reveal information related to the length of time of such third party use, Honda's knowledge of such use, and Honda intentional abandonment of its rights in the Proposed Mark due to a failure to enforce its alleged rights against such use.

C. Documents Relating to the GP Engines Are Relevant to Functionality and Secondary Meaning

Honda does not dispute that the GP Engines embody the Proposed Mark. Opp. at 13. As such, the requested documents are relevant to functionality and lack of secondary meaning. Documents related to the design and development of the GP engines are relevant to functionality because they will show that Honda is using the Proposed Mark for functional, non-source identifying reasons (e.g. for a compact GP engine design).³ Moreover, Applicant's decisions on how to differentiate the GP Engines from the GX Engines through color differences (GP in white and black versus the GX in red, white and black), as opposed to differences in shape, is relevant to show that the primary significance of the product shape is to identify the product itself rather than the source of the product. *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S.

³ Additionally Applicant is incorrect in its assertion that "[t]he fact that a cheaper engine can embody the same mark demonstrates that the design is *not* functional." Opp. at 13 (emphasis in original). The ability to manufacture a product configuration more cheaply does not make the product configuration any less functional. Likewise, the ability to produce a cheaper engine that "embod[ies] the same mark" does not establish that the documents are irrelevant to functionality. In fact, it does just the opposite: it demonstrates that documents relating to the design, styling, and external appearance of the engines are relevant to this proceeding. Since Applicant has claimed that the

844, n. 11 (1982). Therefore, the GP Engine Requests are directly relevant to lack of secondary meaning.

Previously in these proceedings, Honda agreed to produce documents related to the design and development of the GX engine, despite the fact that the design documents existed in Japan, because that engine embodies the Proposed Mark. The GP engine also embodies the Proposed Mark, and as such, documents related to its design and development are also relevant here. Honda's only argument as to why it should not have to produce these otherwise relevant documents is that GP engines are not sold in the United States. Honda fails to cite any authority for the proposition that otherwise relevant documents are rendered irrelevant simply by virtue of relating to products sold outside the United States, and in fact the law is to the contrary.⁴ See *Tequila Centinela, S.A. DE C.V. v. Bacardi & Co.*, 242 F.R.D. 1 (D.D.C. 2007); *Laker Airways Ltd. v. Pan Am. World Airways*, 103 F.R.D. 42 (D.D.C. 1984). Simply put, a design that is functional abroad is still functional in the United States. Therefore, the Board should compel discovery of the GP Engine Requests.⁵

III. HONDA HAS FAILED TO DEMONSTRATE THAT PRODUCING THE DOCUMENTS WILL BE BURDENSOME

Honda argues in conclusory fashion that production of the requested documents would be "unduly burdensome" and that the "burden of producing the documents . . . is not proportional to the benefits." Applicant's Brief at 10 and 14. However this argument fails for three reasons: (1)

engines "embody the same mark," Opposers should be able to test Applicant's statement that the engines are functionally different through discovery.

⁴ Furthermore, Applicant's attempt to distinguish *Tequila Centinela* and *Laker Airways Ltd.* is erroneous. Discovery in *Centinela* was not limited to the United States. See *Tequila Centinela, S.A. DE C.V. v. Bacardi & Co.*, 242 F.R.D. 1, 17 (D.D.C. 2007). Additionally, the *Laker* court did compel discovery of the documents, but opted to delay entry of its ruling 30 days to allow the German government the opportunity to voluntarily comply with the interim order. See *Laker Airways Ltd. v. Pan Am. World Airways*, 103 F.R.D. 42, 57 (D.D.C. 1984).

⁵ Additionally, the Board never imposed a wholesale restriction on document production to the United States. Opp. at 14. Instead, the Board only limited certain of Honda's document requests relating to advertising and communication with advertisers to the United States. Dkt. 40.

as demonstrated above, the documents are extremely relevant to the proceeding, (2) Honda has failed to submit any evidence demonstrating burden and (3) Applicant's ability to easily locate documents relating to the testing of third party engines without model numbers belies its burden argument.

A. Applicant Failed to Support its Burden Claim with Evidence

Honda failed to submit any evidence in support of its claim of burden. As a result, this objection fails as a matter of law. *See The Phillies v. Philadelphia Consolidated Holding Corp.*, 107 U.S.P.Q.2d 2149 (TTAB 2013) (denying protective order because opposers merely stated in a conclusory fashion that disputed discovery requests were unduly burdensome); *McLeod, Alexander, Powel & Apffel, P.C. v. Quarles*, 894 F.2d 1482, 1485 (5th Cir. 1990) (holding that merely stating in a conclusory fashion that discovery requests are burdensome is insufficient to demonstrate burden). Here, Applicant's failure to provide evidence of how or why they are unduly burdensome requires that the objection be overruled.

B. Honda Does Not Need Model Numbers To Locate Relevant Third Party Engines

Honda's contention that the Third Party Engine Requests are unduly burdensome because there are an unascertainable amount of Third Party Engines with the same configuration as the Proposed Mark is belied by (1) its own Internet search identifying each manufacturer's relevant engines, as noted in its Opposition Brief, and (2) its own actions after Opposers filed this motion, namely its ability to easily locate relevant documents in its October 22, 2014 production. Opp. at 10-11. Indeed, after Opposers filed this motion, Honda conceded that the Third Party Engine Requests regarding Honda's purchase, inspection and testing of third party engines were relevant and not burdensome, and Honda withdrew those objections and produced documents regarding Honda's testing of similar third party engines manufactured by JD and Lifan. Honda was

obviously able to locate the relevant documents by conducting a simple search of its records regarding competitive designs, which Honda tracks in the ordinary course of business. There is no need to limit the requests to specific model numbers, as that would likely cause relevant documents to escape production. Indeed, Honda's business records frequently refer to competitive third party horizontal shaft engines by brand name (e.g. "Subaru," "Briggs," "Kohler"), and not by model number. Moreover, model numbers change, but third party manufacturing and sale of similarly shaped engines does not. Honda has already demonstrated that it can easily find documents relating to third party engines without restricting the requests, and therefore, the Board should compel Applicant to comply with its discovery obligations and produce these documents.⁶

Furthermore, Applicant's attempt to distinguish the documents it requested from Opposers in 2013 is unavailing. Applicant splits hairs between engines with a "similar configuration," the language used in Opposers' Motion, and engines "embodying the mark," the language Applicant used in its August 21, 2012 Motion to Compel. The Board should not be misled by this attempt at word play. *See* Opp. at 8 – 10. Even if Honda is correct that the third party engines merely have a "similar configuration" to the Proposed Mark, documents related to those engines would still be relevant for purposes of discovery. Third party engines that utilize the same or highly similar shape, configuration, and function are relevant to show functionality and lack of secondary meaning regardless of how each party chooses to define them in their moving papers.

Lastly, it is disingenuous for Applicant to now deny that that "similarly shaped" third party engines embody the Proposed Mark. Indeed, despite significant differences in appearance,

⁶ Furthermore, Honda's assertion that it has produced "more than 100,000 pages of requested documents," misconstrues the record. Opp. at 2. As detailed in Dkt 29, at 2 Applicant's production has primarily consisted of

Applicant has sent cease and desist letters to Opposers regarding Opposers' engines, claiming they are using Applicant's Proposed Mark in violation of Applicant's alleged trademark rights. *See* Dkt. 55, Ex. 28 & 29. Applicant cannot have it both ways. If Opposers' engines allegedly infringe the Proposed Mark, then Third Party Engine Requests directed at engines that are even more similar in appearance, and that Honda has responded to without objection, are highly relevant to the issues in this proceeding. *See* Decl. of Phillips, Ex. A.

CONCLUSION

Opposers respectfully request that the Board enter an Order requiring Honda to produce documents responsive to the subject requests within thirty (30) days of its Order and grant any such further relief as is just.

Dated: November 19, 2014

By: /s/ Robert N. Phillips

Robert N. Phillips
Reed Smith LLP
101 Second Street
San Francisco, CA 94105

Attorneys for Opposer *Briggs & Stratton Corporation*

Dated: November 19, 2014

By: /s/ Donald A. Daugherty, Jr.

Donald A. Daugherty, Jr.⁷

Godfrey & Kahn, S.C.
780 North Water Street
Milwaukee, WI 53202-3590

Attorneys for Opposer *Kohler Co.*

documents produced and pleadings filed in prior federal court actions in the mid-2000's.

⁷ As of November 17, Attorney Daugherty is a shareholder with the Godfrey & Kahn, S.C. law firm, and no longer affiliated with Whyte Hirschboeck Dudek, S.C. Kohler has directed Whyte Hirschboeck Dudek to transfer the file to Godfrey & Kahn so that Attorney Daugherty can continue as its counsel. Notice of substitution pleadings will be filed with the Board shortly in order to formally accomplish the transfer.

CERTIFICATE OF SERVICE

It is hereby certified that a true copy of the foregoing OPPOSERS BRIGGS & STRATTON CORPORATION AND KOHLER CO.'S REPLY IN SUPPORT OF MOTION TO COMPEL PRODUCTION OF DOCUMENTS FROM APPLICANT HONDA GIKEN KOGYO KABUSHIKI KAISHA was served on the following counsel of record for Applicant, by depositing in the U.S. mail this 19th day of November, 2014.

Michael J. Bevilacqua, Esq.
Wilmer Cutler Pickering Hall and Dorr LLP
60 State Street
Boston, MA 02109-1800
Phone: (617) 526-6448
Fax: (617) 526-5000

/s/ Deborah Kalahale

Deborah Kalahale

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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BRIGGS & STRATTON CORPORATION and
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HONDA GIKEN KOGYO KABUSHIKI KAISHA,

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Opposition No. 91200832 (parent)

Opposition No. 91200146

Application Serial No. 78924545

**DECLARATION OF ROBERT N. PHILLIPS IN SUPPORT OF OPPOSER BRIGGS &
STRATTON CORPORATION AND KOHLER CO.’S REPLY IN SUPPORT OF
MOTION TO COMPEL DOCUMENTS FROM APPLICANT HONDA GIKEN KOGYO
KABUSHIKI KAISHA**

I, Robert N. Phillips, declare as follows:

1. I am a partner in the law firm of Reed Smith LLP, counsel of record for Briggs & Stratton Corporation (“Briggs”). The matters set forth herein are based upon my personal knowledge, except where otherwise indicated, and if called as a witness I could and would testify competently thereto.

2. Attached hereto as **Exhibit A** are true and correct images of the U.S. Trademark Application Serial No. 78,924,545, engines manufactured by Opposers’ Kohler and Briggs that Honda claimed embody the Proposed Mark, and third party engines that are the subject of Opposers’ Third Party Engine Request and that Honda claims merely have a similar configuration to the Proposed Mark.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. Executed on the 19th day of November, 2014 at San Francisco, California.

/s/ Robert N. Phillips

Robert N. Phillips

CERTIFICATE OF SERVICE

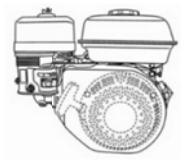
It is hereby certified that a true copy of the foregoing DECLARATION OF ROBERT N. PHILLIPS IN SUPPORT OF OPPOSER BRIGGS & STRATTON CORPORATION AND KOHLER CO.'S REPLY IN SUPPORT OF MOTION TO COMPEL DOCUMENTS FROM APPLICANT HONDA GIKEN KOGYO KABUSHIKI KAISHA was served on the following counsel of record for Applicant, by depositing in the U.S. mail this 19th day of November, 2014.

Michael J. Bevilacqua, Esq.
Wilmer Cutler Pickering Hall and Dorr LLP
60 State Street
Boston, MA 02109-1800
Phone: (617) 526-6448
Fax: (617) 526-5000

/s/ Deborah Kalahale
Deborah Kalahale

Exhibit A

Proposed Mark:



U.S. Trademark Application Honda GX
Serial No. 78,924,545

Opposers' Engines That Honda Claimed "Embody the Proposed Mark":



Kohler SH265-3031



Briggs & Stratton 83132-
1035-F1

Third Party Engine Request Designs That Honda Claims Merely Have a "Similar Configuration" to the Proposed Mark:



Generac
212CC OHV Engine



V Power Equipment
212cc Hemi Head High
Performance Engine (60363)



V Power Equipment
212CC 7HP



Blue Max 6783



Jiangdong JF120



Jiangdong JF240



Lifan LF168F-2



All-Power
APE7006V